

**REMARKS**

This Amendment is responsive to the Office Action mailed November 20, 2007. Applicants submit concurrently herewith a Petition for Extension of Time for three months up to and including May 20, 2008.

Claims 1-25 were pending in the application. In the Office Action mailed November 20, 2007, claims 1-25 have been rejected. In the instant Amendment, claim 22 has been canceled, without prejudice, and claims 1, 3-6, 9, 15, 23 and 24 have been amended. Upon entry of the instant Amendment, claims 1-21 and 23-25 will be pending in the application.

Claim 1 has been amended to recite that the hydroxide present in the phase separated reaction mixture *consists of* a metal hydroxide, and that paspalic acid and the metal hydroxide are present in amounts sufficient to cause the phase separated reaction mixture. Support for the claim as amended is found in the specification at, e.g., page 3, paragraph [0012], and page 4, paragraph [0016].

Claims 3-4 have been amended to correct a grammatical error.

Claims 4-6, 9 and 15 have been amended to eliminate improper multiple dependencies.

Claims 23 and 24 have been amended to depend from claim 16.

No new matter has been added by these amendments. Entry of the foregoing amendments and consideration of the following remarks are respectfully requested.

**THE EXAMINER'S REQUIREMENT FOR AN ABSTRACT**

The Examiner has stated that the application does not contain an abstract, and required that an abstract be submitted. Although Applicants respectfully point out that an abstract was included on the first page of the corresponding International Publication WO 2005/082902, Applicants submit herewith a copy of

the abstract on a separate sheet. The submitted abstract is the same as that which was published in WO 2005/082902, and therefore contains no new matter.

**THE REJECTIONS UNDER 35 U.S.C. § 102**

Claims 1-21 have been rejected under 35 U.S.C. § 102(b) as being anticipated by *Gaullier*, U.S. Patent 6,242,603 ("*Gaullier*"). Applicants submit that *Gaullier* does not teach a phase separated reaction mixture containing paspalic acid and an aqueous solution of a metal hydroxide, and without any other hydroxide.

In *Gaullier*'s Examples 1 and 2, the reactions are carried out in either a solution of tetraalkyammonium hydroxide (see, *Gaullier* Example 1 at col. 2, lines 5-22) or a solution containing a mixture of tetraalkyammonium hydroxide and sodium hydroxide (see, *Gaullier* Example 2 at col. 2, lines 25-41). When the term "consisting of" appears in one clause of a claim, rather than in the preamble of the claim, it limits only the elements set forth in that clause; the phrase does not prevent the claim as a whole from reading on devices that have additional elements not recited in the claim. *Mannesmann Demag Corp. v. Engineered Metal Products Co., Inc.*, 793 F.2d 1279, 1282, 230 U.S.P.Q. 45, 46 (Fed. Cir. 1986). Thus, the presently claimed process excludes the use of tetraalkyammonium hydroxide. Accordingly, the processes of *Gaullier*'s Examples 1 and 2 do not anticipate the presently claimed process.

*Gaullier* also discloses comparative tests in which paspalic acid is isomerized using a 2N aqueous solution of sodium hydroxide without any tetraalkyammonium hydroxide (see, *Gaullier* at col. 2, lines 42-63). However, there is no mention that a phase separation mixture was formed in these processes. The present specification teaches that to form a phase separated mixture, the concentration of paspalic acid and metal hydroxide must be present in the reaction mixture in sufficient amounts

(see, e.g., page 3, paragraph [0012], second sentence). In Paragraph [0014], the present specification teaches that in preferred embodiments, the concentration of paspalic acid is at least about 5 wt%, and the concentration of the metal hydroxide is at least 12 wt% aqueous solution. Based on Applicants' calculation as shown in Table 1, below, the amounts of paspalic acid and the metal hydroxide are not sufficient to cause a phase separated reaction mixture.

Table 1 concentrations of paspalic acid and metal hydroxide in Comparison Test A and B of *Gaullier*

	Paspalic acid (wt %)	Metal hydroxide (wt %)
Comparison Test A	4.4 <sup>1</sup> (col. 2, line 45)	7.1 <sup>2</sup> (col. 2, line 45)
Comparison Test B	1.4 <sup>3</sup> (col. 2, lines 56-57)	5.5 <sup>4</sup> (col. 2, line 56)

Therefore, claims 1-21 of the present application are not anticipated by *Gaullier*. Withdrawal of the rejection is respectfully requested.

Claims 22-25 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Sandoz, GB 988,001 ("*Sandoz*"). The rejection is moot with respect to cancelled claim 22. Applicants first respectfully point out that *Sandoz*

<sup>1</sup> The concentration of paspalic acid is calculated as follows: 100 ml of 2N NaOH aqueous solution has a weight of 100 g (water) + 8 g (NaOH) = 108 g. The total weight of the paspalic solution is therefore 5 g (paspalic acid) + 108 = 113 g. The concentration of paspalic acid is  $5/113 = 4.4\%$ .

<sup>2</sup> The concentration of NaOH is calculated as follows: the total weight of the paspalic solution is 113 g (see footnote 4). The concentration of NaOH is  $8/113 = 7.1\%$ .

<sup>3</sup> The concentration of paspalic acid is calculated as follows: the total weight of the paspalic solution is 5 g (paspalic acid) + 360 g (0.5N KOH in 50:50 water:ethanol) = 365 g. The concentration of paspalic acid is  $5/365 = 1.4\%$ .

<sup>4</sup> The concentration of KOH is calculated as follows: the weight of KOH in 360 g of 0.5N KOH in a water:ethanol (50:50) is about 20 g (assuming 50:50 vol:vol). The total weight of the paspalic solution is 365 g (see footnote 3). The concentration of NaOH is  $20/365 = 5.5\%$ .

teaches processes for producing lysergic acid derivatives, not processes for producing lysergic acid. In fact, the teachings of Sandoz cited by the Examiner (Sandoz, page 2, lines 76-82) relate to washing a lysergic acid derivative, 1-methyl-lysergic acid. In addition to the cancellation of claim 22, Applicants have amended claims 23 and 24 to depend from claim 16. The rejection is rendered moot with respect to claims 23, 24 and 25 as well.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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